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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,600	10/04/2001	William H. Wisecarver III	1480-R-00	1951
35811	7590	06/12/2008		
IP GROUP OF DLA PIPER US LLP ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103			EXAMINER	
			DASS, HARISH T	
			ART UNIT	PAPER NUMBER
				3692
			MAIL DATE	DELIVERY MODE
			06/12/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/970,600	WISECARVER ET AL.
	<b>Examiner</b> Harish T. Dass	<b>Art Unit</b> 3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 09 April 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No. (s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/2008 has been entered.

##### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Patent statute does not allow patents to be issued on particular business systems and method that depend for their operation on human intelligence alone. In case of claim 1, a computer implemented method for payment transactions between a consumer and a merchant unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101, since mental processes standing alone are not patentable, even if they have practical applications. Claims 1 and 3 can be carried out by mental steps and do not link to any of patentable statutory class. The claims 1 and 3, at issue do not use of machine and does not describe process of manufacture or process for alteration

of composition of matter, and since claim instead cover use of mental processes to solve the step of determining financial product to purchase and purchasing amount for maximizing objective function on the basis of input data, and thus seek to patent use of human intelligence in and of itself. Ref: In re Comiskey, 84 USPQ2d 1670(Fed. Cir.2007).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheong et al. (hereinafter Cheong – US 7,006,993) in view of Hutchison et al (hereinafter Hutchison – US 20050192896) and Cohen (US 2003/0097331 A1).

Re. Claim 1, Cheong discloses opening an account for online shopping [Abstract], and verifying electronically that the Consumer (customer) has an established credit card account [abstract; col. 9 lines 12-20 – see funding a surrogate account...], creating an electronic data account (account) [Abstract; col. 1 line 53 to col. 2 line 25]; authorizing an amount of credit within the financial account of limited access [Abstract; Figures 10,

14; col. 1 line 53 to col. 2 line 25., executing a purchase transaction having a dollar amount within the established purchasing limit; after executing the purchase transaction, requesting funds from the customer's established credit card account and routing the funds to the merchant. Cheong does not explicitly disclose establishing (opening) a purchasing limit and storing the purchasing limit in the data account (account), and lock box and where the lock box does not store funds. However, credit card transaction is old and well-known, where the merchant forwards the customer receipt to merchant account bank with total collection amount and during the process the customer's available credit limit is reduced to new value. For example, a customer with outstanding purchasing limit of \$10,234.23 (max limit – total spending up to this point) charges another \$1000.00, the new limit is reduced to \$9234.23 (see any consumer's credit card statement), the merchant bank collect the money from credit card company less the credit card fee and forwards to merchant (deposit to merchant account) the collected amount less banks processing fees/commission.

Similarly smart cards are known which have memories for holding the spending limits, upper limit, password, controlling the spending limits and authorization for higher limits, and transaction history and can be used where the merchant does not need to get authorization like regular cards.

Hutchison discloses a virtual account, establishing (opening) a purchasing limit and storing the purchasing limit in the data account (account) [abstract; para. 55, 65]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong and include the above

feature, as disclosed by Hutchison, to check the payments against the stored data and determine whether a spending limit has been exceeded and prevent the transaction in event the spending is above the limit which reduces fraud and extra cost associated with purchases that may rejected by credit card companies.

Cohen discloses lock box and where the lock box does not store funds [See at least paragraphs 41, 104, 118 "electronic safety deposit **boxes**", 415]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong and Hutchison and include lock box and where the lock box does not store funds, as disclosed by Cohen,. To provide an electronic deposit box associated with the webbank for storage, access, and recordkeeping of a user's important documents and assets and control of fund transfer and authorization of payment in e-commerce.

Re. Claim 2, Cheong discloses creating a data account number and access code and confirming the credit amount and access code [col. 15 lines 15-18 – see "debit card" which has account number and access code and when it is used the system validates the access code and the card limit before processing further], the method further comprising the steps of: accessing a merchant via a computer network [col. 1 lines 18-27; col. 6 lines 18-50]; performing procedures for on-line purchasing [col. 1 lines 18-27; col. 6 lines 18-50]; entering the account number, and entering the access code [Figure 2 and associated description; col. 22 lines 32-67]; electronically routing the data account (account) number and access code to a service provider; and routing a request for

funds totaling the dollar amount of the transaction to the credit card issuer [figure 47; col. 24 lines 33-56; col. 30 lines 52-64].

Re. Claim 4 & claim 5, claim 4 and claim 5 are rejected with same rational as claim 1.

Re. Claim 6, claim 6 is rejected with same rational as claim 2.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheong, Hutchison and Cohen, as applied to claims 1 & 5, and in view of Gustin et al (hereinafter Gustin - US 2005/0035193).

Re. Claims 3 & 7, Cheong discloses debiting the financial account of limited access the amount electronically transferred [col. 1 lines 17-27; col. 2 lines 1-13].

Further, Gustin et al (US 2005/0035193) discloses wiring the amounts of the transaction to the merchant less any discount fee [paragraphs 12-14, 141, 178 – see reduced fee]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong, Hutchison and

Cohen and include limitation disclosed by Gustin to improve the payment for online shopping using known wire transferring means to expedite the transaction.

***Response to Arguments***

3. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Harish T Dass/  
Primary Examiner, Art Unit 3692

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